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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,034

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EXAMINER

COLE, ELIZABETH M

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

07/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/523,034

**Applicant(s)**

HOJO ET AL.

**Examiner**

Elizabeth M. Cole

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11, 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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1. Claims 2-4, 7, 8, 11, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims merely setting forth physical characteristics desired in an article and not setting forth specific compositions, which would meet such characteristics are invalid as vague and indefinite because they cover any conceivable combination of ingredients, either presently existing or which might be discovered in the future. The claims are indefinite since they purport to cover everything which will perform the desired functions regardless of its composition and, in effect, recites compounds by what it is desired that they do rather than what they are. Ex parte Slob (PO BdApp) 157 USPQ 172. In claim 4, it is not clear what pores are being referred to, no material having pores is recited in any of the independent claims. Does this refer to pores between the particles or within the particles, (i.e., interparticle pores or intraparticle pores?). The same problems are present in claims 7-9. Also, it is not clear whether it is the inorganic compound or the additive which is in particle form.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-9, 11, 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 870,435. EP '435 discloses a composition comprising a water insoluble mineral such as calcium carbonate, magnesium carbonate, calcium phosphate, magnesium phosphate, silicates, (see p. 4, line 49 – p. 5, line 15), having a particle size of preferably 0.2 um or less, (p. 6, lines 16-25), wherein the particles of the water insoluble mineral are mixed with additives such as lecithin, organic acid esters, and surfactant such as polyglycerol esters of fatty acids, sucrose esters of fatty acids, etc, (p. 3, lines 49-56), wherein the additive is present in amounts of 0.01% by weight or more, up to 20% by weight or less and the water insoluble mineral is present in an amount of 1% by weight or more, up to 50% by weight or less, (p. 6, lines 43-55). EP '435 does not disclose the BET specific surface area or that the composition satisfies the equations set forth in the claims, however, since EP '435 discloses the same materials in the same amounts and since the particles are within the size range claimed, it is reasonable to presume that the compositions of EP '435 would satisfy the equations set forth in the claims. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention the examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112- 2112.02.

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5. With regard to the limitation that the composition is a flower thinning agent, since this statement is a statement of intended use and since the composition of EP '435 is capable of performing this intended use since it is the same composition, EP '435 meets this limitation. Further, it is noted that this limitation appears in the preamble of the claim. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. Applicant's arguments filed 5/7/07 have been fully considered but they are not persuasive.

7. With regard to the 112 2<sup>nd</sup> paragraph rejections, Applicant argues that the 112 2<sup>nd</sup> paragraph rejection is vague. However, the rejection states that the claims as filed recited an inorganic compound having a particle size range, and surface area, but did not recite any materials and that the claims are therefore vague and indefinite. Claim 1 has been amended to recite the particular inorganic compound and additive used so the rejection is overcome as far as claim 1. However, it is maintained for the claims 2-4, 7, 8, 11, 13 since these do not recite what the various components are. Further, while Applicant also argues that the terms inorganic compound and additive are defined in the specification, it is noted that while the claims are interpreted in light of the specification,

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limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. With regard to claim 4, Applicant has amended the claim to recite the pore diameter of the flower thinning agent is measured by a particular method, but the claim still does not recite where the pores are and whether they are interparticle or intraparticle pores. Therefore, the rejection is maintained.

9. With regard to the art rejection, Applicant argues that the examiner has not presented a proper basis in fact and/or technical reasoning for the inherency rejection. However, the basis for the rejection is that EP '435 discloses the same materials in the same amounts and since the particles are within the size range claimed, it is reasonable to presume that the compositions of EP '435 would satisfy the equations set forth in the claims. The examiner is not able to make the materials and then test them to see if they satisfy the equations, but since the reference teaches the same materials, same particles sizes and same amounts, there is a reasonable basis to assume that the reference has the same properties and for the examiner to shift the burden of proof to the applicant.

10. Applicant argues that the purpose of the composition of EP '435 is different from the purpose of the claimed composition, and that there is therefore no basis for the assumption that the material of EP '435 would have the claimed properties. However, as set forth above, regardless of what the purpose of the material is, the compositions appear to be the same. Two materials which are the same composition cannot have different properties.

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11. Applicant argues that the only overlap in the particle size is between 0.03 –0.04 um. However, the claims encompass the entire claimed range. The disclosed particle size of EP '435 is within the claimed range. In order to anticipate the claims it is not required that the reference teach the entire range.

12. Applicant argues again that the reference material is used for different things than the claimed invention. However, as long as the structures and compositions overlap, it is reasonable to presume that the properties of the materials are the same. The burden is on Applicant to show otherwise.

13. Applicant argues that the surface area is not discussed in EP '435. However, since the same materials and particle sizes are used, it is reasonable to assume that the surface area would be the same.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.



Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771

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